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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,071	10/13/2005	Thomas Siebel	BE-165PCT	2724
40570 7590 01/30/2008 FRIEDRICH KUEFFNER 317 MADISON AVENUE, SUITE 910 NEW YORK, NY 10017			EXAMINER STEWART, JASON-DENNIS NEILKEN	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 01/30/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/553,071

Applicant(s)

SIEBEL, THOMAS

Examiner

Jason-Dennis Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

The following is a Final Office action in response to communications received 11/19/2007. Claims 3 and 4 have been cancelled. Claims 1 and 5 have been amended. Therefore, Claims 1, 2, and 5-10 are pending and addressed below.

### ***Response to Amendment***

Applicant's amendments to the claims and specification are sufficient to overcome the objections to the drawings. However, these amendments are insufficient to overcome the objections to Claims 3 and Claim 5.

### ***Claim Objections***

1. Claim 3 is objected to because of the following informalities: Examiner maintains that "perpendicular" has been added in error in line 7 of the claim. As per Applicant's disclosure, the Applicant illustrates (Fig. 1, 2) parts that are joined with one another in the direction of the longitudinal axis of the neck of the femur, not perpendicular to the longitudinal axis of the femur. Appropriate correction is required.
2. Claim 5 is objected to because of the following informalities: Element (15) is referred to as a "guide block", but is referred to throughout the specification and in a subsequent claim as an "anchoring block" (Claim 10, Figures 1 and 2). Appropriate correction is required.

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3. Claims 5-9 are objected to because of the following informalities: Claim 5 depends from a claim that was previously cancelled (claim 3). Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar et al 5,389,107 in view of Hwang 5,725,597.
6. Claim 1 is drafted in *Jepson* format. Doing so is taken by the Examiner as an implied admission that the subject matter of the preamble is the prior art work of another. **See MPEP 2129, section III.**

Nassar et al discloses a ball portion (30) and an insert (16) that is secured to the upper end of the femur. He also teaches, "in response to a load or impact force exceeding a compressive threshold, indicated by arrows (48), being applied to the femur (18), thereby causing piston (34) to advance in chamber (36) and compress spring (42)," thus deforming when the femur is placed under a sufficient load. Nassar also discloses a "piston (34) that is slidably received by an axial chamber (36) formed in

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the upper end of the insert (16). Nassar discloses an invention consisting of parts that are joined in a series. (Abstract, ll. 2-4) Nassar further discloses that "piston (34) extends into and is slidably engaged in close tolerance with the inside wall of bushing (38). As a result, piston (34) and attached ball (30) are slidable as directed by chamber (36), and as indicated by double-headed arrow (41)."

However, Nassar does not disclose the parts are rotatable about an axis extending perpendicular to the longitudinal axis of the neck of the femur.

Hwang discloses a shaft 19 that is rotatable about an axis extending perpendicular to the longitudinal axis of the neck of the femur and is adapted to support axial and radial loads applied to the shaft by the weight of the user (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Nassar with the rotatable shaft of Hwang in order to reduce abrasion of the acetabulum cup as taught by Hwang (abstract).

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar et al 5,389,107 in view of Hwang 5,725,597 further in view of Copf 2003/00114123.

Nassar teaches the invention as claimed and as discussed above. However, Nassar does not teach the following limitations taught by Copf: "the anchoring part (31) is designed as a stump that freely terminates distally in the bone tissue (5)." (Figures 3a-b).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar in view of Hwang 5,725,597 further in view of Copf in order

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to conserve femoral bone and to secure a fit of the implant as taught by Copf in paragraph 5, ll. 9-15.

8. Claims 5 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar et al 5,389,107 in view of Hwang 5,725,597 further in view of Martin 2001/0007957. Nassar teaches the invention as claimed and as discussed above. However, Nassar does not teach the following claimed limitations taught by Martin: "a first part consisting of an anchor block (520) and a guide stem (528) that projects from the anchoring block in the direction of the longitudinal axis of the neck of the femur, and a second part consists of a guide block with a guide channel (516) that receives the guide stem (528)" (Figure 27, 28, Paragraph 174).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar in view of Hwang and further in view of Martin in order to secure the prosthesis to the bone matter, and to secure the different parts of the apparatus together, as taught by Martin in the abstract, ll. 21-25.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar 5,389,107 in view of Hwang 5,725,597 and Martin 2001/0007957, and further in view of White 2002/0151984. Nassar i.v. Martin teaches the invention as claimed and as discussed above. However, Nassar i.v. Martin does not teach the following claimed limitations taught by White: "the guide channel (16) is expanded relative to the guide stem (30), and the second part (12) can be rotated relative to the first part about an axis that is perpendicular to the longitudinal axis of the neck of the femur" (Paragraph 14, 18; Figure 1-13).

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It would have been obvious to one of ordinary skill art at the time of the invention to modify Nassar in view of Hwang and Martin and further in view of White in order to permit internal adjustment of the prosthesis relative to the bone, as taught by White in Paragraph 18.

10. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar 5,389,107 in view of Hwang 5,725,597 in view of Martin 2001/0007957 and further in view of Rauscher 6,423,097. Nassar i.v., Martin teaches the invention as claimed and as discussed above. However, Nassar i.v., Martin does not teach the following claimed limitations taught by Rauscher: "projections located opposite each other formed in the guide channel (14,15), and the first part (4) can rotate on these projections like a rocker relative to the second part. Also, Nassar i.v., Martin also does not teach the following claimed limitations taught by Rauscher: "the opposing projections (14,15) have rounded rolling surfaces, so that the projections rest against the guide stem (12) in each rotational position of the second part"(Figures 1,3,8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar in view of Hwang as modified by Martin, and further in view of Rauscher in order to form a point of rotation on the shaft axis, as taught by Rauscher (Column 3, ll. 38-39, Figures 1,3,8) for better stability.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar 5,389,107 in view of Hwang 5,725,597 and further in view of Copf 2003/0014123. Nassar teaches the invention as claimed and as discussed above. However, Nassar does not teach the following claimed limitation that is taught by Copf: "an annular recess

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(43), which can become filled by bone tissue (7) growing into it", (Figure 4, paragraph 34 & 39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar in view of Hwang and further in view of Copf in order to ensure the spongy substance (trabecular bone) can grow as easily as possible into the openings, as taught by Copf in paragraph 31, ll. 4-7.

### ***Response to Arguments***

12. Applicant's arguments filed 11/19/2007 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 1 and have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Nassar does not disclose parts being rotatable about an axis perpendicular to the longitudinal axis of the neck of the femur. Hwang has been used as a teaching reference that shows this limitation. The Applicant's argument of the mobility of parts taking place in an implanted state is found in the preamble of a *Jepson* claim, and therefore, it is not given patentable weight.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, as per the Notice of References Cited.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

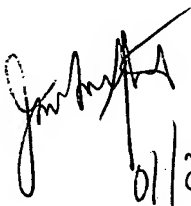
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason-Dennis Stewart whose telephone number is (571)270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571)272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS

  
01/28/08

BRIAN E. PELLEGRINO  
PRIMARY EXAMINER

